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EXAMINER

MAUNG, N

ART UNIT

PAPER NUMBER

2744

DATE MAILED: 12/31/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/442,383

Applicant(s)

Harvey et al.

Examiner

Nay Maung

Group Art Unit

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☒ Responsive to communication(s) filed on Aug 15, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This Office Action is responsive to the amendment(s) filed 8/15/97.

DOUBLE PATENTING V.S. PATENTS

2. After reviewing the restriction requirement under 35 USC 121 in US Patent 5,233,654 it is believed that the claims of the instant application are subject to a double patenting analysis against US Patent 5,233,654 and US Patent 5,335,277.

3. In view of further analysis and applicant's arguments, the rejection of the claims in the instant application under double patenting based on the broad analysis of *In re Schneller* as set forth in paragraphs 7-10 of the previous Office Action has been withdrawn.

4. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

DOUBLE PATENTING BETWEEN APPLICATIONS

5. Conflicts exist between claims of the following related co-pending applications which includes the present application:

#	Ser. No.	#	Ser. No.	#	Ser. No.
1	397371	2	397582	3	397636
4	435757	5	435758	6	437044
7	437045	8	437629	9	437635
10	437791	11	437819	12	437864
13	437887	14	437937	15	438011
16	438206	17	438216	18	438659
19	439668	20	439670	21	440657

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22	440837	23	441027	24	441033
25	441575	26	441577	27	441701
28	441749	29	441821	30	441880
31	441942	32	441996	33	442165
34	442383	35	442335	36	442369
37	442383	38	442505	39	442507
40	444643	41	444756	42	444757
43	444758	44	444781	45	444786
46	444787	47	444788	48	444887
49	445045	50	445054	51	445290
52	445294	53	445296	54	445328
55	446123	56	446124	57	446429
58	446430	59	446431	60	446432
61	446494	62	446553	63	446579
64	447380	65	447414	66	447415
67	447416	68	447446	69	447447
70	447448	71	447449	72	447496
73	447502	74	447529	75	447611
76	447621	77	447679	78	447711
79	447712	80	447724	81	447726

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82	447826	83	447908	84	447938
85	447974	86	447977	87	448099
88	448116	89	448141	90	448143
91	448175	92	448251	93	448309
94	448326	95	448643	96	448644
97	448662	98	448667	99	448794
100	448810	101	448833	102	448915
103	448916	104	448917	105	448976
106	448977	107	448978	108	448979
109	449097	110	449110	111	449248
112	449263	113	449281	114	449291
115	449302	116	449351	117	449369
118	449411	119	449413	120	449523
121	449530	122	449531	123	449532
124	449652	125	449697	126	449702
127	449717	128	449718	129	449798
130	449800	131	449829	132	449867
133	449901	134	450680	135	451203
136	451377	137	451496	138	451746
139	452395	140	458566	141	458699

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142	458760	143	459216	144	459217
145	459218	146	459506	147	459507
148	459521	149	459522	150	459788
151	460043	152	460081	153	460085
154	460120	155	460187	156	460240
157	460256	158	460274	159	460387
160	460394	161	460401	162	460556
163	460557	164	460591	165	460592
166	460634	167	460642	168	460668
169	460677	170	460711	171	460713
172	460743	173	460765	174	460766
175	460770	176	460793	177	460817
178	466887	179	466888	180	466890
181	466894	182	467045	183	467904
184	468044	185	468323	186	468324
187	468641	188	468736	189	468994
190	469056	191	469059	192	469078
193	469103	194	469106	195	469107
196	469108	197	469109	198	469355
199	469496	200	469517	201	469612

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202	469623	203	469624	204	469626
205	470051	206	470052	207	470053
208	470054	209	470236	210	470447
211	470448	212	470476	213	470570
214	470571	215	471024	216	471191
217	471238	218	471239	219	471240
220	472066	221	472399	222	472462
223	472980	224	473213	225	473224
226	473484	227	473927	228	473996
229	473997	230	473998	231	473999
232	474119	233	474139	234	474145
235	474146	236	474147	237	474496
238	474674	239	474963	240	474964
241	475341	242	475342	243	477547
244	477564	245	477570	246	477660
247	477711	248	477712	249	477805
250	477955	251	478044	252	478107
253	478544	254	478633	255	478767
256	478794	257	478858	258	478864
259	478908	260	479042	261	479215
262	479216	263	479217	264	479374
265	479375	266	479414	267	479523

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268	479524	269	479667	270	480059
271	480060	272	480383	273	480392
274	480740	275	481074	276	482573
277	482574	278	482857	279	483054
280	483169	281	483174	282	483269
283	483980	284	484275	285	484276
286	484858	287	484865	288	485282
289	485283	290	485507	291	485775
292	486258	293	486259	294	486265
295	486266	296	486297	297	487155
298	487397	299	487408	300	487410
301	487411	302	487428	303	487506
304	487516	305	487526	306	487536
307	487546	308	487556	309	487565
310	487649	311	487851	312	487895
313	487980	314	487981	315	487982
316	487984	317	488032	318	488058
319	488378	320	488383	321	488436
322	488438	323	488439	324	488619
325	488620	326	498002	327	511491
328	485773	329	113329		

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6. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. The attached Appendix provides clear evidence that such conflicting claims exist between the 329 related co-pending applications identified above. However, an analysis of all claims in the 329 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

In order to resolve the conflict between applications, applicant is required to either:

- (1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other ⁸~~329~~ applications, or;
- (2) provide an affidavit attesting to the fact that all claims in the 329 applications have been reviewed by applicant and that no conflicting claims exists between the applications. Applicant should provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications, or;
- (3) resolve all conflicts between claims in the above identified 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications (note: the five examples in the attached Appendix are merely illustrative of the overall problem. Only correcting the five identified conflicts would not satisfy the requirement).

Failure to comply with the above requirement will result in abandonment of the application.

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INFORMATION DISCLOSURE STATEMENTS

7. Receipt is acknowledged of applicant's Information Disclosure Statements filed 8/15/97.

In view of the unusually large number of references cited in the instant application (approximately 2,200 originally and 645 in the subsequent IDS) and the failure of applicant to point out why such a large number of references is warranted, these references have been considered in accordance with 37 C.F.R. 1.97 and 1.98 to the best ability by the examiner with the time and resources available.

The foreign language references cited therein where there is no statement of relevance or no translation are not in compliance with 37 C.F.R. 1.98 and have not been considered. Numerous references listed in the IDS are subsequent to applicant's latest effective filing date of 9/11/87, therefore, the relevancy of these references is unclear. Also cited are numerous references that are apparently unrelated to the subject matter of the instant invention such as: US Patent # 33,189 directed toward a beehive, GB 1565319 directed toward a chemical compound, a cover sheet with only the word "ZING", a computer printout from a library search with the words "LST" on it and a page of business cards including that of co-inventor James Cuddihy, among others. The relevancy of these references cannot be ascertained. Furthermore, there are several database search results listed in foreign languages (such as German) which list only the title and document information; no copy has been provided, therefore, these references have not been considered.

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CLAIM REJECTIONS - 35 USC § 112

8. Claims 14-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

37 C.F.R. 1.75(d)(1) requires that:

“the terms and the phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description”.

The following limitations were not supported by the specification as originally filed:

In claim 14, “transfer devices”.

9. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, the phrase "adapted to" in line 3 is vague and indefinite.

Regarding claim 14, the phrase "adapted to" in line 8 is vague and indefinite.

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Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

11. Claims 2, 3, 5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al (Saeki).

Consider claim 2. Saeki discloses a method for providing a function at a receiver station (fig. 1, item 2), the receiver station having a data network (fig. 1, item 1), a processor (fig. 2a, item 35), an input device (fig. 2a, item 44), and a data storage device (fig. 2a, item 42), the method comprising the steps of:

receiving from the input device a set of information collection parameters (i.e. a command button 0-10, which is the parameters, for receiving a set of information collection as shown in figs. 4-8, cols. 7-8);

generating a query from the set of information collection parameters at the receiver station (fig. 4, i.e. which information do you need?);

promulgating the query from the step of generating a query from the receiver station to the data network through the data network connection (the user entering the command, for example, 1 for weather forecast as shown in fig. 4, and promulgating the query, the command, from the receiver station to the data network); and

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receiving operating instruction in response to the step of promulgating a query (receiving operating instruction such as display information about the weather; col. 7, lines 3-55);

storing the operating instructions a the storage device (col. 7, lines 3-28).

Consider claim 3. Saeki further discloses the steps of processing or outputting information on the basis of the operating system instructions at the receiver station (in fig. 4-8);

storing a data record evidencing the step of processing or outputting (storing a data record, for example, the user input command 1, which is stored in the video data memory 42); and

transferring the data record form the step of processing or outputting from the receiver station storage device to a data collection station on the data network through the data network connection (the data record, the user input command 1 which is transferred to the data collection station for the display information; col. 7, lines 1-55).

Consider claim 5. Saeki discloses a method for providing and tracking a receiver station's (fig. 1, item 2) use of a function in a data network collection station, the receiver station having a data network (fig. 1, item 1), a processor (fig. 2a, item 35), an input device (fig. 2a, item 44), and a data storage device (fig. 2a, item 42), the method comprising the steps of:

providing operating instructions or executable code to a plurality of receiver stations from the plurality of data source (fig. 1, 27) (fig. 4, col. 7, lines 1-55);

performing a function based on the operating instruction or executable code at the receiver station (fig. 4, col. 7, lines 1-55);

recording an identification (i.e. command 0-10) of the function performed at the step of performing a function at the receiver station on the data storage device (recording an

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identification, for example the user input command 1, which is transferred to the data collection station for the display information; col. 7, lines 1-55); and

transferring the record of identification of the function performed at the receiver station to a data collection station on the data network through the receiver station network connection (the data record, the user input command 1 which is transferred to the data collection station for the display information; col. 7, lines 1-55).

Consider claim 7. Saeki further discloses the function in the step of performing a function is a series of numerical functions performed on a computer (the command data is performing at the data network computer 26).

12. Claims 8-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al (Campbell).

Consider claim 8. Campbell discloses in figure 1 and 2, a method of delivering and gathering information on the use of a control signal in a communication network, the network comprising a transmitter station (fig. 1, item 20) and receiver station (fig. 1, item 12, 16), the transmitter station being capable of receiving queries and communicating program materials and data (col. 4, lines 41-48), the receiver station comprising an input device for inputting a command (fig. 2, program source), a processor for receiving programming instruction and communicating information (fig. 2, PCs 50), and a computer for storing data and controlling presentations (fig. 2, PCs 50; col. 7, lines 16-31), the method comprising the steps of:

programming the computer to store a portfolio of data that designate a plurality of personal interests of a subscriber (i.e. weather, news, stock, and other; col. 5, lines 5-15);

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querying the transmitter station for data of programming of interest (col. 4, lines 41-48);
receiving some portion of a presentation control signal or some mass medium
programming (as depicted in figure. 11) on the basis of a comparison with information stored in
the computer (col. 13, lines 1-68);

presenting a unit of mass medium programming at a computer peripheral location (fig. 6,
item 104; col. 9, lines 62-68) on the basis of the data or programming of interest received from
the transmitter station (i.e. movies are present at the computer peripheral location 36, 40); and
communicating from the receiver station a datum of the unit of mass medium
programming or the portion of a presentation control signal (as shown in fig. 11; col. 13, lines 1-
68).

Consider claim 9. Campbell discloses (fig. 1 and 2), a method of controlling a plurality of
receiver stations each of which includes a television receiver (40), a signal detector (fig. 6, item
112), a processor (fig. 6, item 104; col. 9, line 62-68), and with each of the receiver station
connected to detect the presence of one or more control signals and programmed to process
downloadable executable code (as shown in fig. 11), the method of controlling comprising the
steps of:

receiving at a transmitter station some downloadable code which is effective at a receiver
station to store operating instructions at a storage device associated with a processor, the
downloadable executable code having at each of the plurality of receiver stations a target
processor to process data (i.e. event enable word as shown in fig. 11 which display a pay-per-
view movie at a particular television receiver 40; col. 12, lines 1-34) ;

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transferring the downloadable code from the transmitter station (fig. 1, items 10, 11) to a transmitter(fig. 1, item 20);

receiving one or more control signals at the transmitter station, the one or more control signals operate to execute the downloadable code (as depicted in fig. 11); and

transferring the one or more controls signals from the transmitter station to the transmitter, and transmitting at least one information transmission comprising the downloadable code and one or more control signals (as depicted in fig. 11 which is transmitted from the transmitter, the head end station, to the television receiver 40).

Consider claim 10. Campbell further discloses wherein the downloadable executable code or some identification data in respect of the downloadable executable code are embedded in a television signal (cols. 5 and 6).

Consider claim 11. Campbell further recites wherein a television program is displayed at a receiver station and the downloadable executable code programs the receiver station processor or computer to output video, audio, or text in the context of the television program or to select information that supplements the television program content (col. 7 and 8).

Consider claim 12. Wherein the one or more control signals incorporate some of the downloadable executable code (fig. 11).

Consider claim 13. Campbell discloses (fig. 1) a method of providing a first function to a receiver station (40) from a remote data source (10, 11), the method comprising the steps of:

storing data at the remote data source (i.e. weather, news, stock, and other; col. 5, lines 5-15);

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receiving at the remote data source at least one of (I) a query for said first function or (ii) a record evidencing availability, use, or usage of a second function from the receiver station (for example a user ordering a pay-per-view movie; col. 17, line 42-64);

transmitting an instruct signal which is effective at the receiver station to store operating instructions (tire code) at a storage device associated with a processor from the remote data source to the receiver station in response to the step of receiving at least one of the query and the record, the receiver station storing the operating instructions (i.e. storing tire code; col. 12, lines 1-34); and

transmitting from a second remote source (fig. 1, item 20) to the receiver station a signal which controls the receiver station to process the operating instructions and perform the function (i.e. authorization is transmitted the converter, receiver station 40, the data control system at the head end to have access to a given channel, col. 12, lines 27-34).

Consider claim 14. Campbell teaches (fig. 1, 2, 6 & 11) a method of controlling a remote intermediate transmitter station (fig. 1; 11) communicate to at least one receiver station (fig. 2; 40), with the remote intermediate data transmitter station including a broadcast or cablecast transmitter (20), a plurality of selective transfer devices (figs. 1; 12, 16) each operatively connected to said broadcast or cablecast transmitter, a receiver for receiving the operating instructions from at least one origination transmitter station, a control signal detector, and a controller or computer capable of controlling at least one of the selective transfer devices (as shown in fig. 11), and with the remote intermediate transmitter station connected to detect the presence of at least one control signal, to control the communication of instruction signal (col.

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13, lines 1-68), and to deliver at its broadcast or cable cast transmitter the at least one instruct signal, the method communicating comprising the steps of:

receiving the at least one instruct signal at the at least one origination transmitter station and delivering the at least one instruct signal to at least one origination transmitter (i.e. channel control word, as shown in fig. 11, being effective at the converter 40), the instruct signal being effective at a receiver station to store at least one operating instructions at a storage device (inherently present in the converter 40) associate with a processor (104) (col. 8, lines 18-62; col. 13, lines 25-60);

receiving the at least one control signal (i.e. 201 as depicted in fig. 11) which at the remote intermediate transmitter station operate to control the communication of the instruct signal (col. 4, lines 26-48); and

transmitting the at least one control signal (i.e. specific movie to be shown at a specific time) to the transmitter before a specific time (col. 12, lines 1-34; col. 15, lines 16-39).

Consider claim 15. Campbell further discloses the step of embedding a specific one of the one or more control signals (fig. 11) or in an information transmission containing the instruct signal before transmitting the instruct signal to the remote transmitter station (col. 3, lines 27-43).

Consider claim 16. Campbell further discloses wherein the specific time is a schedule time of transmitting the instruct signal or some information associated with the instruct signal from the remote intermediate data transmitter station and the one or more control signals are effective at the remote intermediate data transmitter station to control one or more of the plurality of selective transmission device at different times (i.e. a plurality of user order a pay-per-view movie which is delivered at different time; col. 12, lines 1-34; col. 17, lines 42-64).

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CLAIM REJECTIONS - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saeki et al (Saeki) in view of Block et al. (Block).

Consider claim 4 and 6. Saeki does not explicitly show the receiver station network connection is a telephone network connection. Nevertheless, using a telephone network connection for data transferring is well-known and commonly use in the data communication art as evidenced by Block.

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Hence, it would have been obvious to one of ordinary skill in the art to use a telephone network in order to transmit data between a data network and a receiver station, as taught by Block, since telephone networks are commonly located in rural area as opposed to CATV broadcast transmission line.

Response to Arguments

15. Applicant's arguments filed 8/15/97 have been fully considered but they are not persuasive.

16. In the remarks, the applicants argued in substance:

17. (A) "Regarding claim 2, applicants submit that Saeki does not disclose the limitation in claim 2 of receiving from an input device a set of information collection parameters. The selection entered on the keyboard in Saeki do not meet this limitation. The keyboard in Saeki is used at the terminal unit to request video data signals. The request is received at the center and then the corresponding video signals are sent to the terminal unit. The video data signal selection in Saeki is not a set of information collection parameters as recited in claim 2.

Further, applicants submit that Saeki does not disclose the limitation in claim 2 of generating a query from a set of information collection parameters at a receiver station ..." (P. 15 of the applicants' argument).

In response to the argument (A), since the applicant does not explicitly show how Saeki's system is different from the present invention, the broadest claimed limitation are still read on Saeki's system. Further, the claimed limitation do not show without using a keyboard. Therefore, as disclosed above paragraph 11, the limitation "information collection parameters" is read on, i.e., a

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command button 0-10, which is the parameters, for receiving a set of information collection as show in figs. 4-8, cols. 7-8 of Saeki.

(B) “Regarding claim 5, applicant submit that Saeki does not disclose the limitation in claim 5 of providing operating instructions or executable code to a plurality of receiver stations from a plurality of data sources. Saeki discloses a center which transmits video data signals to a terminal upon receiving a request for the specific video data signals from the terminal. Saeki does not disclose or suggest providing operating instructions to a plurality of receiver stations. Saeki does not discloses or suggest providing executable code to a plurality of receiver stations. (PP. 15-16 of the applicants’ argument).

In response to the argument (B), the broadest claimed limitation “providing operating instructions to a plurality of receiver stations” which is read on Saeki’ system, i.e., a peripheral equipment station 27 which provides operating instruction to a plurality of receiver stations 2 in fig. 1, for example, which information do you need? in order to operate the particular function such as ticket reservation. In addition, the limitation “executable code” is read on the commands 0-10 in order to execute the function such as weather forecast.

(C) “Regarding claim 8, applicants submit that Campbell does not disclose the limitation in claim 8 of programming a computer at a receiver station to store a portfolio of data that designate a plurality of personal interest of a subscriber. Campbell discloses that the text formatter in the headend transmitter station can receive data form a wide variety of source such as weather, news and stock. However, these items in Campbell do not meet the limitation of a portfolio of data that designate a plurality of personal interests of a subscriber as recited in claim 8... Campbell does not disclose the limitation in claim 8 of querying a transmitter station for data

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of programming of interest... Campbell does not disclose or suggest that the headend transmitter is queried for data of programming interest. (PP. 8-9 of the applicants' argument).

In response to the argument (C), the broadest claimed limitation "a portfolio of data that designate a plurality of personal interest of a subscriber" is definitely read on a wide variety of source such as stock that is a personal interest of a subscriber, and which is querying by a transmitter station (col. 4, lines 41-48 and col. 5, lines 5-15).

(D) "Regarding claim 9, applicant submit that Campbell does not disclose the limitation in claim 9 of receiving at a transmitter station downloadable code which is effective at a receiver station to store operating instructions at a storage device associated with a processor... The event enable word in figure 11 of Campbell, and referenced in the Office Action, does not meet the limitation in claim 9 of operating instructions... The event enable word in figure 11 of Campbell is not downloadable code..." (PP. 17-18 of the applicants' argument).

In response to the argument (D), the limitation "receiving at a transmitter station downloadable code which is effective at a receiver station to store operating instructions at a storage device associated with a processor" is read on Saeki, as described above paragraph 11, i.e., in col. 12, lines 1-34 states that "...addressable tiers, special events and eligibility codes. These different types of access control are all effected by a one-way system of the present invention using an intelligent converter at each subscriber location which can compare program codes sent from the head end station identifying each television program ... Preferably each converter on the cable system has its own individual identification number... the control data system program the addressable converter to compare each program tier code with the tire code of the subscriber". Therefore, the broadest claimed limitation "receiving at a transmitter station

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downloadable code” which is addressable tires, special event and eligibility code disclosed in Saeki. Further, the broadest limitation “which effected at receiver station to store operation instructions at a storage device” which is read on comparing program code sent from the head end station which inherently store at the converter in order to compare with the store code. identifying each television program to user codes in order to operate and instruct displaying of a pay-per-view movie.

(E) “Regarding claim 14, applicants submit that Campbell does not disclose the limitation in claim 14 of receiving an instruct signal at an origination transmitter station and delivering the instruct signal to an origination transmitter, the instruct signal being effective at a receiver station to store operating instruction at a storage device associated with a processor. The channel control word in Campbell, and referenced in channel control word in Campbell is used at the receiver station to determine if the receiver station is allowed access to the transmitter television programming... Campbell does not disclose or suggest operating instructions. The channel control word in Campbell is not effective at a receiver station to store anything... (PP. 18-19 of the applicants’ argument).

In response to the argument (E), the broadest claimed limitation “ receiving an instruct signal at an origination transmitter station and delivering the instruct signal to an origination transmitter, the instruct signal being effective at a receiver station to store operating instruction at a storage device associated with a processor” is read on Saeki as described above paragraph 11, i.e., channel control word which is an instruct signal which effective at the convert 40 to store operating system instruction such as a pay-per-view movie to play at a different time col. 12, lines 1-34.

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(F) “Regarding claim 4, applicants submit that for at least the same reasons discussed in response to... Further, applicants submits that there would be no motivation for one skilled in the art to combine the teaching... Applicant submit that one using a CATV closed system would not be motivated to combine this with the use of a much slower and noisier telephone line system when use of the telephone lime system result in on substantial improvement over the existing cable system...

Regarding claim 6, applicants submit that for at least the same reasons discussed in response... As stated previously, applicants submit that there would be no motivation for one skilled in the art to combined the teaching of Saeki with the teachings of Block... Applicant submit that one using a CATV closed system would not be motivated to combine this with the use of a much slower and noisier telephone line...” (PP. 20-21 of the applicants’ argument).

In response to the argument (F), the applicant's argument that “ there would be no motivation for one skilled in the art to combine the teaching... Applicant submit that one using a CATV closed system would not be motivated to combine this with the use of a much slower and noisier telephone line system when use of the telephone lime system result in on substantial improvement over the existing cable system...” , the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

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Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

19. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nay Maung whose telephone number is (703) 308-7745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

N. Maung
December 7, 1997



DWAYNE BOST
SUPERVISORY PATENT EXAMINER
GROUP 2700

APPENDIX

(Examples of Claim Conflicts between Applications)

- Comparison of claim 12 from Serial No. 08/469,626 to claim 24 from Serial No. 08/487,980.

Claim 12

- A method of controlling a remote intermediate mass medium programming transmitter station to communicate mass medium program material to one or more receiver stations, with said remote transmitter station including a broadcast or cablecast transmitter for transmitting one or more units of mass medium programming, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of mass medium programming, a mass medium programming receiver, a control signal detector, and a controller or computer capable of controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific units of mass medium programming in response to detected specific

Claim 24

- A method of controlling a remote intermediate mass medium programming transmitter station to communicate mass medium program material to one or more receiver stations, with said remote transmitter station including a broadcast or cablecast transmitter for transmitting one or more units of mass medium programming, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of mass medium programming, a mass medium programming receiver, a control signal detector, and a controller or computer capable of controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific units of mass medium programming in response to detected specific

control signals, and to deliver at its broadcast or cablecast transmitter one or more units of mass medium program, said method of communicating comprising the steps of:

(1) receiving a unit of mass medium programming to be transmitted by the remote intermediate mass medium programming transmitter station and delivering said unit of mass medium programming to a transmitter, said unit of mass medium programming having an instruct signal which is effective at the one or more receiver stations to *control a sequence of events*;

(2) receiving one or more control signals which at the remote intermediate mass medium programming transmitter station operate to control the communication of said unit of mass medium programming; and

(3) transmitting said one or more control signals to said

control signals, and to deliver at its broadcast or cablecast transmitter one or more units of mass medium program, said method of communicating comprising the steps of:

(1) receiving a unit of mass medium programming to be transmitted by the remote intermediate mass medium programming transmitter station and delivering said unit of mass medium programming to a transmitter, said unit of mass medium programming having an instruct signal which is effective at the one or more receiver stations to *decode a portion of a multichannel broadcast or cablecast transmission*;

(2) receiving one or more control signals which at the remote intermediate mass medium programming transmitter station operate to control the communication of said unit of mass medium programming; and

(3) transmitting said one or more control signals to said

transmitter before a specific time.

transmitter before a specific time.

Comparison of claim 24 from Serial No. 08/488,620 to claim 23 from Serial No. 08/477,660.

Claim 24

A method of controlling a computer to communicate a television signal in a television network, said network *having* a television transmitter station and a television receiver station, said receiver station having a computer for communicating of television signals, said method comprising the steps of:

programming *said receiver station* to search for data embedded in a television signal;

inputting an identifier code that designates a unit of computer software;

storing a television signal on a file storage medium at a storage device associated with said computer;

receiving from a remote source an information transmission that contains a control signal;

Claim 23

A method of controlling a computer to communicate a television signal in a television network, said network *comprised of* a television transmitter station and a television receiver station, said receiver station having a computer for communicating of television signals, said method comprising the steps of:

programming *a processor* to search for data embedded in a television signal;

inputting an identifier code that designates a unit of computer software;

storing a television signal on a file storage medium at a storage device associated with said computer;

receiving from a remote source an information transmission that contains a control signal;

selecting a storage location associated with said computer in response to said control signal;

transferring said unit of computer software to said storage device;

storing said unit of software on said file storage medium;

executing a technique for communicating a file stored on a disk associated with a computer; and

communicating said television signal in accordance with said technique.

selecting a storage location associated with said computer in response to said control signal;

transferring said unit of computer software to said storage device
and

storing said unit of software on said file storage medium,

thereby to enable said computer to execute a technique for communication a file stored on a disk associated with a computer and

communicate said television signal in accordance with said technique.

Comparison of claim 23 from Serial No. 08/488,032 to claim 58 from Serial No. 08/451,746.

Claim 23

A method of communicating subscriber station information from a subscriber station to one or more remote data collection stations, said method comprising the steps of:

(1) inputting a viewer's or participant's reaction at a subscriber station;

(2) receiving at said subscriber station information that designates an instruct signal to process or an output to deliver in consequence of subscriber input;

(3) determining the presence of said subscriber input at said subscriber station by processing said viewer's or participant's reaction;

(4) processing an instruct signal which is effective to *coordinate data processing with communication or presentation* of television programming at said

Claim 58

A method of communicating subscriber station information from a subscriber station to one or more remote data collection stations, said method comprising the steps of:

(1) inputting a viewer's or participant's reaction at a subscriber station;

(2) receiving at said subscriber station information that designates an instruct signal to process or an output to deliver in consequence of *said specific* subscriber input;

(3) determining the presence of said *specific* subscriber input at said subscriber station by processing said viewer's or participant's reaction;

(4) processing an instruct signal which is effective to *receive, generate, or present output to supplement* television

subscriber station in consequence of said step of determining; and

(5) transferring from said subscriber station to one or more remote data collection stations an indicia confirming delivery of said instruct signal from said step of processing or confirming delivery of said effect from said step of processing.

programming at said subscriber station in consequence of said step of determining; and

(5) transferring from said subscriber station to one or more remote data collection stations an indicia confirming delivery of said instruct signal from said step of processing or confirming delivery of said effect from said step of processing.

Comparison of claim 47 from Serial No. 08/469,106 to claim 46 from Serial No. 08/487,649.

Claim 47

A method of controlling at least one of a plurality of receiver stations each of which includes a broadcast or cablecast mass medium program receiver, at least one output device, a control signal detector, at least one processor capable of responding to an instruct signal, and with each said mass medium program receiver station adapted to detect and respond to one or more instruct signals, said method of communicating comprising the steps of:

(1) receiving at a broadcast or cablecast transmitter station an instruct signal which is effective at the receiver station to *implement a scheme for generating a control signal* and delivering the instruct signal to a transmitter;

(2) receiving at said transmitter station one or more

Claim 46

A method of controlling at least one of a plurality of receiver stations each of which includes a broadcast or cablecast mass medium-program receiver, at least one output device, a control signal detector, at least one processor capable of responding to an instruct signal, and with each said mass medium program receiver station adapted to detect and respond to one or more instruct signals, said method of communicating comprising the steps of:

(1) receiving at a broadcast or cablecast transmitter station an instruct signal which is effective at the receiver station to *select a broadcast or cablecast signalling scheme and generate a signal in consequence of said selected broadcast or cablecast signalling scheme* and delivering the instruct signal to a transmitter;

(2) receiving at said

control signals which at the receiver station operate to communicate the instruct signal to a specific processor; and

(3) transferring said one or more control signals to the transmitter, said transmitter transmitting the instruct signal and the one or more control signals.

transmitter station one or more control signals which at the receiver station operate to communicate the instruct signal to a specific processor; and

(3) transferring said one or more control signals to the transmitter, said transmitter transmitting the instruct signal and the one or more control signals.

Comparison of claim 11 from Serial No. 08/477,805 to claim 25 from Serial No. 08/449,523.

Claim 11

A method of controlling a remote television transmitter station to communicate television program material to one or more receiver stations, with said remote television transmitter station including a broadcast or cablecast transmitter for transmitting one or more units of television programming, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of television programming, a television receiver, a control signal detector, and a controller or computer capable of controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific units of television programming in response to detected specific control signals, and to deliver at

Claim 25

A method of controlling a remote television transmitter station to communicate television program material to one or more receiver stations, with said remote television transmitter station including a broadcast or cablecast transmitter for transmitting one or more units of television programming, a plurality of selective transmission devices each operatively connected to said broadcast or cablecast transmitter for communicating a unit of television programming, a television receiver, a control signal detector, and a controller or computer capable of controlling one or more of said selective transmission devices, and with said remote transmitter station adapted to detect the presence of one or more control signals, to control the communication of specific units of television programming in response to detected specific control signals, and to deliver at

its broadcast or cablecast transmitter one or more units of television programming, said method of communicating comprising the steps of:

(1) receiving a unit of television programming to be transmitted by the remote intermediate television transmitter station and delivering said unit of television programming to a transmitter;

(2) receiving one or more control signals which at the remote intermediate television transmitter station operate to control the communication of *a specific one or more of said plurality of units* of television programming; and

(3) transmitting said one or more control signals to said transmitter before a specific time.

its broadcast or cablecast transmitter one or more units of television programming, said method of communicating comprising the steps of:

(1) receiving a unit of television programming to be transmitted by the remote intermediate television transmitter station and delivering said unit of television programming to a transmitter, *said unit of television programming having an instruct signal which is effective at the one or more receiver stations to implement a television signalling scheme;*

(2) receiving one or more control signals which at the remote intermediate television transmitter station operate to control the communication of *said unit* of television programming; and

(3) transmitting said one or more control signals to said transmitter before a specific time.